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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,702	06/29/2000	Mark R. Johansen	470AM	7467

7590 05/06/2005

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EXAMINER

ELOSHWAY, NIKI MARINA

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 05/06/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/606,702
Filing Date: June 29, 2000
Appellant(s): JOHANSEN, MARK R.

MAILED
MAY 05 2005
Group 3700

William H. Francis (Reg. No. 25,335)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 28, 2005.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect. Appellant states that "an advisory Office Action was mailed on August 3, 2004 which rejected only under the first paragraph of 112 for the first time claims 23, 25, 26 and 28-36 as containing new matter and refused entry even for appeal of claims 37 and 38" (page 3 line 20 through page 4 line 1 of Appeal Brief filed February 28, 2005). This statement is incorrect. Claims 23, 25, 26 and 28-36 were rejected under 35 U.S.C. 112, first paragraph in the Final Office Action mailed March 24, 2004. Claims 37 and 38 were denied entry in the Advisory Action mailed August 3, 2004.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 23, 25, 26 and 28-36 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground of rejection is applicable to the appealed claims:

Claims 23, 25, 26 and 28-36 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations that the cap is separated, disposed over the opening and sealed to the opening prior to the filling of the container, is considered new matter and is not supported by the original disclosure.

(11) Response to Argument

Claims 23, 25, 26 and 28-36 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, in the Final Office Action mailed March 24, 2004.

This rejection was necessitated by the amendment filed December 22, 2003. The amendment filed December 22, 2003 added limitations to independent claims 23 and 32. Among the added limitations were six recitations of "before filling the container" (three recitations in each independent claim).

Specifically, claims 23 and 32 were amended to set forth that the cap is separated from the flash section, disposed over the opening and welded to the container **before filling the container**.

There are at least two problems with the addition of "before filling the container" to the claims. First, the application, as originally filed, did not state at which point, in the manufacture of the container, the container is filled with fuel or any other substance. Second, the limitation "before filling the container" is not limited to the addition of fuel to the container, since the container may be filled with a variety of substances. An explanation of these two arguments follows.

1. The original disclosure does not state when the container is filled.

The original specification sets forth that the container is blow molded (page 5 line 17 through page 6 line 4), the cap is compression molded (page 6 line 5 through page 7 line 7), the cap is separated

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(page 7 line 10-14), and the cap is welded to the container (page 7 lines 15-19). The original application does not state or describe that the container is filled after separating the cap, disposing the cap over the opening, and heat welding the cap to the container. The original application does not state when or how the container is filled, in fact, the filling of the container is not mentioned at all in the original application.

One of ordinary skill in the art, after reading the original application, would not be certain that the container is filled after separating the cap, disposing the cap over the opening, and heat welding the cap to the container. It is possible that the container could be filled prior to disposing the cap over the opening. The container may be filled with any liquid to test for leaks prior to permanently attaching the cap to the container. The container may also be filled with fuel and then subsequently emptied prior to heat welding the cap to the container for testing purposes. Furthermore, the container may be filled with a liquid to cool it down to room temperature at any time after blow molding the container. Since other logical possibilities exist, one of ordinary skill in the art could not clearly ascertain that the container is not filled with anything prior to separating the cap, disposing the cap over the opening, and heat welding the cap to the container.

2. The phrase "before filling the container" is not limited to the addition of fuel.

The phrase "before filling the container" is not limited to the addition of fuel. The container may be filled with any gaseous, liquid or solid material because the claim does not specifically recite that the container is filled with fuel after permanently securing the cap. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The disclosed method of blow molding the container requires the container to be filled with air prior to separating the cap, disposing the cap over the opening, and heat welding the cap to the container. The filling of the container with air during the blow molding process contradicts the

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limitations that the cap is separated, disposed over the opening and heat welded to the container **before filling the container**. The filling of the container with a pressurized fluid is discussed in the specification on page 5 line 21 through page 6 line 3. The original application does not support the limitations that the cap is separated, disposed over the opening, and heat welded to the container before filling the container because the container is filled with pressurized fluid during the blow molding process.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Miki M. Eloshway

Examiner

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April 29, 2005

Conferees

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